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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,239	01/31/2002	Satoshi Mochizuki	219007US0	6551

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/059,239Applicant(s)
MOCHIZUKI et alExaminer
J. DOTEGroup Art Unit
1756

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 2/27/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 & 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The reference US 6,368,765 listed on the form PTO-1449 filed in Paper No. 5 on Feb. 24, 2003, has been crossed-out by the examiner because applicants did not provide a copy of the reference. 37 CFR 1.98(a)(2) requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

The application numbers in the listing of US applications 10/843,357 and 10/845,449, listed on the Information disclosure statement filed in Paper No. 5 on Feb. 24, 2003, have been corrected by the examiner to read US applications 09/843,357 and 09/845,449, respectively. Applications 10/843,357 and 10/845,449 do not exist as of the mailing date of this office action.

2. The disclosure is objected to because of the following informalities:

(1) The specification at page 2, lines 33-35, discloses that "epoxy resin of said epoxy resin moiety includes at least two kinds of bisphenol epoxy resins" (emphasis added). The instant specification previously discloses a "polyol resin moiety" obtained by reacting an epoxy resin. There is no disclosure of an epoxy resin moiety.

(2) The use of trademarks, e.g., Lionol Blue FG-7351 [sic: LIONOL BLUE FG-7351] at page 16, line 25, has been noted in

this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. This example is not exhaustive. Applicants should review the entire specification for compliance.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 are indefinite in the phrase "said epoxy resin of said epoxy resin moiety" (emphasis added) for lack of unambiguous antecedent basis in claim 1. Claim 1 previously recites that the copolymer comprises a polyol resin moiety and a polyester resin moiety, where the polyol resin is obtained by the

reaction of an epoxy resin and the components labeled (b) and (c). Claim 1 does not recite that the copolymer comprises an epoxy resin moiety.

Claim 1 is further indefinite in the phrase "includes at least two kinds of bisphenol epoxy resins having different number-average molecular weights" (emphasis added) because it is not clear what is the scope of the term "kinds." The term "kinds" is not defined in the claim or in the instant specification. Does the term "kinds" refer to the number-average molecular weight, the chemical composition, or to some other property, such as Tg?

Claim 8 is indefinite in the phrase "[a] full color image forming apparatus" because it is not clear what is the scope of said term. The specification merely uses the term "a full color image forming apparatus." The specification does not define or provide any examples of a full color image forming apparatus to provide guidance for determining the scope of the phrase.

Claim 8 is further indefinite in the phrase "apparatus comprising a toner vessel" because it is not clear what is the structural relationship between the apparatus and the toner vessel. The claim does not recite any structural relationship between the apparatus and toner vessel.

5. Claims 1-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The prior art of record does not teach or suggest a toner comprising the copolymer recited in the instant claims.

US 5,840,456 (Tomita) discloses a toner comprising a binder resin comprising a polyol resin and a polyester resin. See example 5 at cols. 18-19. The polyol resin and polyester resin are obtained using components that are within the compositional limitations of the polyol resin and polyester resin moieties recited in instant claims 1, 4, 5, and 7. However, Tomita does not disclose or suggest a copolymer comprising both a polyol resin moiety and a polyester moiety as recited in the instant claims.

US 5,986,017 (Katagiri) discloses a toner comprising a crosslinked polyester resin obtained by using 0.1 to 3 mol% of trimellitic acid and 0.1 to 5 mol% of an "epi-bis type epoxy." See example 1 at col. 10. The "epi-bis type epoxy" is defined at col. 5, lines 47-65. Katagiri's crosslinked polyester resin is not within the scope of the copolymer recited in the instant claims. Nor does Katagiri disclose or suggest a copolymer comprising both a polyol resin moiety and a polyester moiety as recited in the instant claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (703) 308-3625. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311 (Rightfax) for after final faxes, and (703) 872-9310 for other official faxes.

Any inquiry of papers not received regarding this communication or earlier communications, or of a general nature or relating to the status of this application or proceeding should be directed should be directed to the Customer Service Center of Technology Center 1700 whose telephone number is (703) 306-5665.

JLD
March 16, 2003

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700